

specification: page 1, lines 15-20, page 6, lines 15-23, and page 7, lines 1-4). Thus, the specification clearly conveys that Applicants had possession of the claimed invention at the time the application was filed. Therefore, the Examiner is kindly requested to withdraw the rejection of Claims 11 and 16 under 35 U.S.C. § 112, first paragraph.

The Rejection of Claims 6, 10, 11 and 16 under 35 U.S.C. § 102(b) should be withdrawn

Claims 6, 10, 11 and 16 stand rejected under 35 U.S.C. § 102(b). The Patent Office has contended that these claims are anticipated by Portail (U.S. Patent No. 2,555,997). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

In order to render a claim anticipated under § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). Portail does not disclose each and every element of the claimed invention.

Portail discloses a sliding contact of electric machines where a thin layer of a lubricant is spread over a commutator 1 via a brush 2. However, Portail does not disclose a brush wherein the brush has a plurality of grooves along the collector-side end face and wherein the grooves are open at each end along the collector-side end face, as recited in amended Claims 6 and 10. Similarly, Portail does not disclose an electric machine having a brush where the collector/commutator has a plurality of grooves.

Claims 11 and 16 depend from, and include all the limitations of, Claims 10 and 6, respectively, and therefore Claims 11 and 16 are likewise not anticipated by Portail.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102 (b), with respect to Claims 6, 10, 11 and 16 is hereby respectfully requested.

The Rejection of Claims 15 and 20 under 35 U.S.C. § 102(b) should be withdrawn

Claims 15 and 20 stand rejected under 35 U.S.C. § 102(b). The Patent Office has contended that these claims are anticipated by Vacha (U.S. Patent No. 2,439,114). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

Vacha discloses conditioning an electrical apparatus collector, where conditioning members 18 are inserted into a current carrying brush 16 to lubricate a commutator 6. However, Vacha does not disclose a brush wherein the brush has a plurality of grooves along the collector-

side end face, and wherein the grooves are open at each end along the collector-side end face, as recited in amended Claims 15 and 20. Similarly, Vacha does not disclose an electric machine having a brush where the collector/commutator has a plurality of grooves. Furthermore, the courts have very clearly stated that "In order to render a claim anticipated under § 102, a single prior art reference must disclose each and every element of the claim in exactly the same way." See Lindeman supra. Vacha simply does not disclose each and every element of the claimed invention.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §102 (b), with respect to Claims 15 and 20 is hereby respectfully requested.

The Rejection of Claims 12 and 17 under 35 U.S.C. § 103 (a) should be withdrawn

Claims 12 and 17 stand rejected under 35 U.S.C. § 103 (a). The Patent Office has contended that these claims are unpatentable over Portail (U.S. Patent No. 2,555,997) in view of Grunewald et al. (U.S. Patent No. 3,841,906). Applicants respectfully submit that this rejection should be withdrawn for at least the following reasons.

The earlier discussion with reference to Portail is incorporated herein by reference since Claims 12 and 17 depend from Claims 10 and 6, respectively.

Grunewald is directed to method of treating a carbon current collection brush blank 11 and brush resulting therefrom. However, Grunewald does not overcome the deficiencies of Portail as applied against Claims 10 and 6, e.g., failure to disclose a brush wherein the brush has a plurality of grooves along the collector-side end face and wherein the grooves are open at each end along the collector-side end face. Additionally, Grunewald discloses the use of zinc or cadmium naphthenate solution to impregnate the carbon brush blank, while Applicants recite in Claims 12 and 17 that the brush is made from carbon, pressed metal powder or alloys thereof. For these reasons, Claims 12 and 17 are not obvious over Portail in view of Grunewald.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a), with respect to Claims 12 and 17 is hereby respectfully requested.

The Rejection of Claims 13 and 18 under 35 U.S.C. § 103 (a) should be withdrawn

Claims 13 and 18 stand rejected under 35 U.S.C. § 103 (a). The Patent Office has contended that these claims are unpatentable over Portail (U.S. Patent No. 2,555,997) in view

obvious over Portail in view of Vacha.

For at least the reasons discussed above, withdrawal of the rejection under 35 U.S.C. §103 (a), with respect to Claims 14 and 19 is hereby respectfully requested.

CONCLUSION

In light of the foregoing, Applicants submit that the present invention is new, non-obvious, and useful, and that all pending claims are in allowable condition. Favorable reconsideration of the claims is respectfully requested.

Respectfully Submitted,

KENYON & KENYON

Dated: September 6, 2001

By:

for Richard L. Mayer

Richard L. Mayer
Reg. No. 22,490

One Broadway
New York, NY 10004
(212) 425-7200

(by J. Lee)
Reg. No.
36,197)